



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Saha *et al.*

Attorney Docket No.
61169.00043 (P-2944)

Application No.: 10/728,496

Group Art Unit: 2624

Filed: December 5, 2003

Examiner: Bernard Krasnic

Title: Method for Measuring Structural Thickness from Low-Resolution Digital Images

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Declaration of Felix W. Wehrli under 37 C.F.R. §1.131

I, Felix W. Wehrli declare that:

1. I am a named and true inventor of U.S. Patent Appl. 10/ 728,496, filed December 5, 2003, claiming an effective filing date of December 5, 2002, when U.S. Provisional Application No. 60/431,129 was filed, the content of which was incorporated into the present application in its entirety.
2. It is my understanding that the United States is the only country in the world that has a “first to invent” law. All other countries use “first to file” laws where the first party to file a patent application on a new invention will generally be the one that gets the patent. In the United States the assertion that one is “first to invent” must be supported by solid, verifiable records of the date of invention, followed by diligent pursuit. Verifiable records may be by: 1) records that are understood and witnessed by unbiased third parties that can and will testify about them in court, 2) contemporaneously prepared (or collected) business records that are believable and that you (or their preparers) can believably swear by, and 3) records that are held by an unimpeachable source (such as the now-ended disclosure program at the U.S. PTO).
3. The Patent Examiner has cited a published paper by Saha, Wehrli, Gomberg and Takahashi, identified by the Examiner as Takahashi *et al.*, *Proc. Intl. Soc. Mag. Reson. Med.* 10

(May 18-24, 2002) as prior art under §§102(a) and 103(a) against the patentability of our claimed invention.

4. As I further understand it, 35 U.S.C. §103(a) states that “A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title.” In turning to 35 U.S.C. §102(a), an Applicant is entitled to a patent unless the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. However, 35 U.S.C. §§102(a) or 103, would not apply to my invention as compared to what the Examiner refers to as the Takahashi reference for the purpose of establishing a priority date. Only section of 35 U.S.C. §102(a) is relevant to the present situation, and since I and my fellow inventors were each authors on the cited paper, clearly the work identified in that paper was not described in a “printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.” Obviously, the information in the cited paper could not have been published unless, and until, my fellow inventors and I had actually conceived of the invention prior to the cited publication in May 2002. Moreover, since the publication date is less than 1 year from the effective December 5, 2002 filing date of our patent application, the cited prior art is not effective prior art. The cited reference did not anticipate or render obvious our present patent application since it actually disclosed portions of our subject invention.

Consequently, Takahashi is not proper “prior” art as applied to our invention.

6. While Dr. Takahashi was named as an author with us on the cited paper, he was not an inventor. Dr. Takahashi was a postdoctoral fellow in the Wehrli laboratory at the University of Pennsylvania, working under my direction and supervision. Dr. Takahashi was included as an author on the cited paper only because Drs. Wehrli, Gomberg and I were using the presently claimed fuzzy distance transform-based computational method for analyzing digital images defining a volumetric region of an object from an image to reexamine earlier data from work that Dr. Takahashi had previously reported. (See reference 5 of cited Takahashi paper). The previously reported work in Dr. Takahashi’s ISMRM paper did not use the presently claimed methods. His previously reported “data” was reexamined by my fellow inventors and me to test and confirm the effect of using the presently claimed method, but Dr. Takahashi was not part of

Applicants' present invention and offered no contribution to its conception. Dr. Takahashi did not operate in the laboratory without the supervision of one or more of the inventors.

7. I unequivocally state that the cited Takahashi reference, antedated by this Declaration, discloses subject matter derived from Drs. Saha, Gomberg and me. It was not subject matter invented by the identified author – Takahashi without our guidance and supervision. Dr. Takahashi was not an inventor.

8. Our invention is neither anticipated, nor obvious, over the cited Takahashi paper, since that paper disclosed parts of our own work, diligently reduced to practice, and the subject of provisional application 60/431,129, establishing the effective filing date of the present utility application.

9. I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: October 8, 2008

Felix W. Wehrli

Felix W. Wehrli